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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,518	05/25/2005	Patrick Jeff Crowley	70126	5169

26748 7590 12/11/2007  
SYNGENTA CROP PROTECTION, INC.  
PATENT AND TRADEMARK DEPARTMENT  
410 SWING ROAD  
GREENSBORO, NC 27409

EXAMINER
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PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY MODE
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12/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/536,518	<b>Applicant(s)</b> CROWLEY ET AL.	
	<b>Examiner</b> Alton N. Pryor	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Applicant's arguments filed 9/28/07 have been fully considered but they are not persuasive. See arguments below.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-22,25-28,30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Baker et al (USPN 4062977; 12/13/77). Baker teaches active compound 9 which is equivalent to instant compound of formula 1 where X,Y,Z = Cl; R1,R2,R3 = CH3; R4,R5 = H. See Table I compound 9. Baker teaches compositions comprising not more than about 15%, preferably 0.1 to 1.0%, of the active compound by weight of the composition. See column 7 line 63 – column 8 line 3. Baker's composition can also comprise adjuvants (carrier). Note the instant specification teaches the active being present in amount ranging from 0.0001 to 95 wt % of the composition. The specification describes this amount as being fungicidally effective. Since Baker's amount of active falls within % wt range disclosed by the instant specification, Baker's composition meets the claim limitation of being a fungicidally effective composition. Baker also teaches a method of applying the composition to seed, plants and soil. See column 6 line 65 – column 7 line 63. Upon considering the above teachings with respect to Baker's invention, it is inherent that Baker's application method would inherently control fungal

growth. This is an inherent property of Baker's invention because Baker teaches the application of instant concentration of identical active compound to plants, seeds, and soil as claimed by applicant.

Claims 19,21-28,30,32 are rejected under 35 U.S.C. 102(b) as being anticipated by Baker et al (USPN 4049423; 9/20/77). Baker teaches active compound 9 which is equivalent to instant compound of formula 1 where X,Z = CH<sub>3</sub>; Y = H; R<sub>1</sub>,R<sub>3</sub>,R<sub>4</sub> = CH<sub>3</sub>; R<sub>2</sub>,R<sub>5</sub> = H. See abstract. Baker teaches the composition comprising 0.5 to 95 % of the active compound by weight of the composition. See column 3 line 55 – column 4 line 11. Baker's composition can also comprise diluents. See column 4 lines 11-36. Note the instant specification teaches the active being present in amount ranging from 0.0001 to 95 wt % of the composition. The specification describes this amount as being fungicidally effective. Since Baker's amount of active falls within % range amount disclosed by the instant specification, Baker's composition meets the claim limitation of being a fungicidally effective composition. Baker also teaches a method of applying the composition to seed and plants. See column 3 line 55 – column 4 line 10. Upon considering the above teachings with respect to Baker's invention, it is inherent that Baker's application would inherently control fungal growth. This is an inherent property of Baker's invention because Baker teaches the application of instant concentration of identical active compound to plants and seeds as claimed by applicant.

*Response to Applicants' argument*

Applicants argue that claims are drawn to fungicidal methods of using compounds of formula I. While the Examiner has noted that active compounds are

disclosed as herbicides in USPNs '977 and '423. The claims are limited to having 60% to 100% fungal control, which prevents Baker from reading on the instant claims. The Baker references do not indicate any fungal control, especially a 60% to 100% control against fungi.

The Examiner argues that both Baker USPNs ' 977 and '423 teach a method having the same active as instantly claimed method, i.e., the step of applying the same active ingredient to seeds, plants or soil. The amount of active being applied in the Baker's references is encompassed by the instant amount active of being applied. For this reason Baker teaches an amount that is fungicidally effective and since the active step in the Baker's references is the same as the active step in the instant claims, i.e. applying the active to seed, plants, or soil, Baker does anticipate the instant invention of controlling fungal growth. Therefore, although Baker does make mention of insecticidal or herbicidal control but does not make mention fungicidal control, it is inherent that Baker's invention inherently controls fungi growth for the above reasons. Because the active step in Baker is the same as the active step in the instant invention and the amount of active being applied in Baker is encompassed by the amount instantly claimed, it is inherent that Baker's invention, like instant invention, would control fungi growth.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20,29, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker US '423 as applied to claims 19,21-28,30,32 above. See 35 USC 102(b) rejection above. Baker teaches all that is recited in claims 20,29, 31 except for variations in X, Z, Y, R5 being between H and Me to arrive at instant compounds of claims 20,29, 31. It would have been obvious to one having ordinary skill in the art at the time of Baker's invention to vary X, Z, Y, R5 being H or Me to arrive at instant compounds of claims 20,29, 31. One would have been motivated to do this because H and Me are chemically equivalent due to similar size and polarity. Chemically equivalent compounds would have been expected to have similar chemical and physical properties and therefore exhibit similar activity.

*Response to Applicants' argument*

Applicants provide a declaration showing the fungicidal activity of instant compounds which are structurally similar to compounds in Baker's 423 patent. However, the declaration does not provide data on any of Baker's compounds for comparison purposes. In the declaration, Applicants conclude that Baker's herbicides would not yield instant fungicidal activity. However, the Declaration does not provide data for any of Baker's compounds in a fungicidal application to support this conclusion. In response to this rejection, the Examiner is requesting that the structure of instant compounds tested as well as the structures of Baker's compounds tested be provided. For this reason the rejection is maintained.

### **New Rejection**

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 19 recites "60% to 100%" which is *new matter*.

#### ***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Alton Pryor', is positioned above the printed name.

Alton Pryor  
Primary Examiner  
AU 1616